

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Final Office Action dated July 25, 2008. Reconsideration and allowance of the application in view of the remarks to follow are respectfully requested.

Claims 1-7, 9-11 and 13-23 are pending in the Application.

In the Office Action, claims 1-23 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 6,033,752 to Suzuki ("Suzuki"). Claims 1, 8-12, 14, 16-18 and 20-23 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by Hosoda ("Hosoda"). It is respectfully submitted that claims 1-7, 9-11 and 13-23 are allowable over Suzuki and Hosoda for at least the following reasons.

Turning first to the 35 U.S.C. §102(b) rejection in view of Hosoda, it is respectfully submitted that Hosoda is not prior art to the present patent application.

35 U.S.C. §102(b) recites in pertinent part that a (emphasis added) "person shall be entitled to a patent unless (b) the invention was patented or described in a printed publication in this or a foreign country ... more than one year prior to the date of the application for patent in the United States ..." Hosoda

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indicates a publication date of December 11, 2003. The present patent application was PCT filed on November 20, 2003 which is prior to the Hosoda publication date. Accordingly, Hosoda can not be prior art under 35 U.S.C. §102(b) or 35 U.S.C. §102(a) which recites in pertinent part that prior art includes material (emphasis added) "patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent ..."

Further, it is respectfully submitted that Hosoda is not prior art under 35 U.S.C. §102(e) to the present patent application. Under 35 U.S.C. §102(e), a reference is only prior art if (emphasis provided) "the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent ..." Under 35 U.S.C. §102(e) it is only the filing date of the U.S. patent application that is considered without regard to any claims for foreign patent application priority benefits.

The present patent application was PCT filed on November 20, 2003 as PCT/IB2003/05410, designates the U.S., is published in English and claims the benefit of a European Patent Application No. EP 02080383.9, filed on December 19, 2002. Accordingly, the

effective filing date of the present patent application is December 19, 2002. Hosoda was filed on May 13, 2003 as U.S. Patent Application No. 10/436,368, however in consideration of Hosoda as prior art against the present patent application, Hosoda does not get a benefit from any foreign filed patent applications and accordingly, has an effective filing date of May 13, 2003.

As the effective filing date of the present patent application of December 19, 2002, precedes the May 13, 2003, filing date of Hosoda, Hosoda is not prior art under 35 U.S.C. §102(e) or under any provisions of 35 U.S.C. §102 with regard to the present application. Accordingly, it is respectfully requested that the rejection of the claims over Hosoda be withdrawn.

Turning to the rejection of claims 1-23 over Suzuki, the Final Office Action indicates the (emphasis added) "metal reflective layer between the second substrate (substrate opposite to the light incident substrate)" (see, Final Office Action, page 2, "Response to Arguments" section), with the second substrate being applied in the rejection of the claims.

The claims are amended herein to clarify that the (emphasis added) "at least one additional layer [is] in contact with the carrier substrate and positioned between the carrier substrate and

the at least first layer ..." Clearly, the second substrate of Suzuki is not in contact with the metal layer. In Suzuki, it is indicated that the "light reflective layer is either provided on top of the aforementioned dielectric layer [on top of the second recording layer 4], or on top of the second recording layer 4 in those instances wherein no dielectric layer is used (see, Suzuki, FIG. 4 and the accompanying description contained in Col. 10, lines 53-55 and Col. 11, lines 11-14).

Accordingly, it is respectfully submitted that the optical information storage medium of claim 1 is not anticipated or made obvious by the teachings of Suzuki. For example, Suzuki does not disclose or suggest, an optical information storage medium that amongst other patentable elements, comprises (illustrative emphasis added) "the storage medium further comprises at least one additional layer in contact with the carrier substrate and positioned between the carrier substrate and the at least first layer, the at least one additional layer comprising at least one sub-layer being a metal" as recited in claim 1, and as similarly recited by each of claims 19 and 20.

Based on the foregoing, the Applicants respectfully submit that independent claims 1, 19 and 20 are patentable over Suzuki and

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notice to this effect is earnestly solicited. Claims 2-7, 9-11, 13-18, and 21-23 respectively depend from one of claims 1 and 20 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration and allowance of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

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Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

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September 25, 2008

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